UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,021	09/19/2001	Kazuhiko Sakamoto		9034

7590   07/21/2004

MATTINGLY, STANGER & MALUR, P.C.
Suite 370
1800 Diagonal Road
Alexandria, VA 22314

EXAMINER
RAMPURIA, SATISH

ART UNIT	PAPER NUMBER
2124	

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/955,021	SAKAMOTO ET AL.
	Examiner	Art Unit	
	Satish S. Rampuria	2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*19 September 2001*</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>*5-17*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>*5-17*</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>*19 September 2001*</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☒ Certified copies of the priority documents have been received in Application No. <u>08/554,632</u>.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
           application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>09/19/2001</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the application filed on 09/19/2001.

2.   This action is in response to the preliminary amendment received on 11/16/2001.

3.   Claims 1-4 has been cancelled by applicant.

4.   Claims 5-17 are pending.

Priority

5.   An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Information Disclosure Statement

6.   An initialed and dated copy of Applicant's IDS form 1449 received on 09/19/2001 is attached to the instant Office action.

Drawings

7.   The drawings (Figs. 1, 17A, 17B, 20A, and 20B) were received on 09/19/2001. These drawings are accepted.

Claim objections

8.   Claims 5, 13, and 14 are objected to because of the following informalities:

Regarding claims 5, 13, and 14 on pages 1, 4, and 5 after the word "display"

delete ":".

Double patenting

9.   The nonstatutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to

prevent the unjustified or improper timewise extension of the "right to exclude"

granted by a patent and to prevent possible harassment by multiple assignees. See

In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*,

759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937,

214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA

1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be

used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly

owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply

with 37 CFR 3.73(b).

Claims 5-17 are rejected under the judicially created doctrine of obviousness-type

double patenting as being unpatentable over claims 1-13, respectively, of US Patent No.

6,330,713 (Application No. 09/548,597), hereinafter called '713 Patent.

This is an obviousness-type double patenting rejection.

The correspondence between the patented claims and the instant claims are as

follows:

Instant claim	Patent claim
5	1
6	2
7	3
8	4
9	5
10	6
11	7
12	8
13	9
14	10
15	11
16	12
17	13

More specifically,

10.　　Claims 5, 9, 13, 14, 15, 16 and 17 are rejected under 35 U.S.C. 103(a) as being

unpatentable over '713 Patent in view of US Patent No. 4,620,279 to Read et al.,

hereinafter called Read.

Per claims 5, 15, 16, and 17:

This claim recites a program generation method for steps specifying navigation

program for displaying and generating a connector program for combining plurality of

programs which steps are recited in the patented claim 1 of '713 Patent. Instant claim

Patented does not recite other features recited as follows in the Instant claim Patented of

'713 Patent. But it would have been obvious for one of the ordinary skill in the art to

modify these features as modified by Read.

The features as follows does not recited on claims 1, 11, 12, and 13 of '713 Patent.

However, Read discloses in an analogous computer system for making said

plurality of programs run together on said information processing apparatus (col. 2, lines

22-35 "independent programs to be run asynchronously and simultaneously on a

computer system... to transfer data... and col. 84, lines 16-17 "running a plurality of

programs on the computer system to transfer data").

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to incorporate the method for running plurality of

programs on a system as taught by Read into the method of generating a program as

taught by '713 Patent. The modification would be obvious because of one of ordinary

skill in the art would be motivated to run plurality of programs to asynchronously running

program to be linked together as suggested by Read (col. 1, lines 56-60).

Claim 9 is the system claim corresponding to method claim 5 and rejected under the

same rational set forth in connection with the rejection of claim 5 above.

Claims 13 and 14 are the computer program product claim corresponding to method

claim 5 and rejected under the same rational set forth in connection with the rejection of

claim 5 above.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section
102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the
subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill
in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the
invention was made.

12.   Claims 5, 6, 8-10, and 12-17 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Patent No. 5,485,615 to Wennmyr, hereinafter called

Wennmyr in view of US Patent No. 4,620,279 to Read et al., hereinafter called

Read.

Per claims 5, 15, 16, and 17:

Wennmyr disclose:

-   A program generation method for generating a program (col. 3, lines 16-17

    "interactive support for the development of a software product according to a

    specified software process") by combining a plurality of programs in an

information processing apparatus having a storage storing a plurality of programs (col. 3, lines "specifying and storing a formal process description") and a navigation program, and a display (col. 3, lines 58-60 "a user interface graphically communicates with the user of the system and allows user input as well"): comprising the steps of:

- (a) specifying a navigation program for displaying information regarding combination of a plurality of programs (col. 3, lines 58-60 "a user interface graphically communicates with the user of the system and allows user input as well"); and

- (b) generating a connector program for combining said plurality of programs based on a parameter outputted from said navigation program (col. 9, lines 13-16 "The browser server 90 allows the user 16 to look for objects in the system data base 36 and to select those objects without direction from the assistant 12."). It is inherent for browser server to connect the appropriate program to display.

Wennmyr does not explicitly disclose for making said plurality of programs run together on said information processing apparatus.

However, Read discloses in an analogous computer system for making said plurality of programs run together on said information processing apparatus (col. 2, lines 22-35 "independent programs to be run asynchronously and simultaneously on a computer system... to transfer data... and col. 84, lines 16-17 "running a plurality of programs on the computer system to transfer data").

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the method for running plurality of programs on a system as taught by Read into the method of generating a program as taught by Wennmyr. The modification would be obvious because of one of ordinary skill in the art would be motivated to run plurality of programs to asynchronously running program to be linked together as suggested by Read (col. 1, lines 56-60).

Per claim 6:

Wennmyr disclose:

- inputting a navigation program stored in a storage of another information processing apparatus (col. 3, lines 48-50 "The interactive support system includes a means for specifying and storing a formal process description") by operating said plurality of programs in response to an instruction inputted to said information processing apparatus (col. 3, lines 58-60 "a user interface graphically communicates with the user of the system and allows user input as well").

Per claim 8:

Wennmyr disclose:

- displaying said retrieved navigation program on said display in a descending order of selection frequency (col. 7, lines 51-60 "... information displayed, for example, may take the form of lists, or could take the form of graphical representations as well as flow charts...").

Claim 9 is the system claim corresponding to method claim 5 and rejected under the

same rational set forth in connection with the rejection of claim 5 above.

Claims 13 and 14 are the computer program product claim corresponding to method

claim 5 and rejected under the same rational set forth in connection with the rejection of

claim 5 above.

13.   Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

       Wennmyr, Read in view of US Patent No. 5,488,714 to Skidmore, hereinafter

       called Skidmore.

Per claims 7 and 11:

Neither Wennmyr nor Read disclose wherein said specifying step is made in accordance

with authorization of a user.

However, Skidmore discloses in an analogous computer system wherein said

specifying step is made in accordance with authorization of a user (col. 20, lines 3-5

"EMA system... interactive by querying the user for approval of automated source code

changes").

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to incorporate the method of authorizing the user to

access the code as taught by Skidmore into the method of generating a program taught in

combination system by Wennmyr and Read. The modification would be obvious

because of one of ordinary skill in the art would be motivated to authorize the user to

provide safely massive code conversion by the authorize user as suggested by Skidmore

(col. 1, lines 35-61).

Conclusion

14.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

The following patent is cited to further show the state of the art with respect to

program generation method.

US Patent No. 5,522,024 to Hiraga et al.

US Patent No. 5,485,615 to Wennmyr

US Patent No. 5,163,130 to Hullot

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Satish S. Rampuria whose telephone number is 703-305-

8891. The examiner can normally be reached on 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kakali Chaki can be reached on (703) 305-9662. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

Satish S. Rampuria
Patent Examiner
Art Unit 2124
07/26/2004

ANIL KHATRI
PRIMARY EXAMINER